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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,597	11/21/2001	Jerome Swartz	467XXBX	4220
7590	04/30/2004		EXAMINER	
Himanshu S. Amin Amin & Turocy, LLP 24th Floor, National City Center 1900 East 9th Street Cleveland, OH 44114			ST CYR, DANIEL	
			ART UNIT	PAPER NUMBER
			2876	
DATE MAILED: 04/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	Application No.	Applicant(s)
	09/990,597	SWARTZ ET AL.
Examiner	Art Unit	
Daniel St.Cyr	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **P riod for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 23 January 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-105 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 33-51,57-74 and 80-98 is/are allowed.

6)  Claim(s) 1-32,52-56 and 75-79 is/are rejected.

7)  Claim(s) 99-105 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

**DETAILED ACTION**

1. Receipt is acknowledged of the amendment filed 1/23/04.

***Claim Objections***

2. Claim 99 is objected to because of the following informalities: lines 4-5, “, the improvement” should be deleted. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 22, 23, 26, 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Gupta et al, US Patent No. 5,361,871.

Gupta et al discloses a product information system for shoppers comprising: a wireless data collecting device 4 having a scanner and a memory for storing scanned product (see col. 8, line 46 to col. 9, line 1); a comprehensive database within the host computer 20 for storing products information; and an intermediate consumer presentation device 2 inherent comprises a communication link for communicating with the wireless data collecting device and the database, a data aggregator for correlating the product on the product list (scanned product) and the information stored in the database, and a display 5 for presenting to the consumer an enhanced presentation of products on the product list and information stored in the database (see figures 1-5; col. 12, line 50+).

Re claim 2, wherein the intermediate device is secured in a shopping cart (see figure 4).

Re claim 3, wherein the display is at least 6" by 6" (see figure and col. 10, line 55+).

Re claims 4, 23, a location tracking agent for determining the approximate location of the intermediate consumer presentation device (see col. 17, using security device for determining the approximate location of the device).

Re claim 5, wherein messaging agent for providing messages to the consumer (providing updating information) (see col. 12, line 50+).

Re claim 6, wherein discount information is displayed (see col. 11, line 60+).

Re claim 7, when sale items are scanned, the display only displays sale items.

Re claim 28, the limitations have been met above.

Re claims 29-32, the unit 2 serves as a kiosk and has means for downloading information from the database.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 8-21, 24, 25, 27, 52-56, and 75-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al. The teachings of Gupta et al have been disclosed above.

Gupta et al fail to disclose or fairly suggest all the details of the method steps including all the information stored in the database, such as data containing behavior characteristic, the location of the product within the establishment, etc.

However, these method steps for establishing a customer database are notoriously old and well known in the art.

It would have been obvious for a person of ordinary skill in the art at the time the invention was made to incorporate the well-known steps into the system Gupta et al to better assist customers when purchasing their goods. Such modification would make the system more effective by providing means to better guide the customer though the establishment and would allow the system to address each individual needs according to their purchase history. Therefore, it would have been an obvious extension as taught by Gupta et al.

*Allowable Subject Matter*

8. Claims 99-105 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

9. Claims 33-51, 57-74, and 80-98 are allowed.

10. The following is a statement of reasons for the indication of allowable subject matter: Although the prior art of record teaches an interactive system for assisting customers which wireless device for communicating to an intermediate device wherein the intermediate device is

linked to a database for accessing updated information, the prior art of record fails to disclose or fairly suggests all the details including setting the wireless device to an in store mode and out of the store mode, a kiosk for linking the communication port of the shopping device, triggering agent for triggering a display, etc. These limitations in conjunction with other limitations in the claims were not shown by the prior art of record.

***Response to Arguments***

11. Applicant's arguments filed 1/23/04 have been fully considered but they are not persuasive. (see examiner remarks).

**REMARKS:**

In response to the applicant argument regarding claim 99, the examiner respectfully disagrees. The objection remains. Appropriate correction is required.

In response to the applicant argument that there is no communication to host computer, the examiner respectfully disagrees. The remote unit is in communication with a host computer 20.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is known in the art that establishing customers' database in order to guide the customers with their shopping needs requires that the database includes customers' characteristic

information. For instance, if a system has to guide customers with food selection based on the ingredients, the database must have information about allowable quantity of ingredient of the customers could in-take in order to properly guide the customers.

The applicant's arguments are not persuasive. Refer to the rejection above.

*Conclusion*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

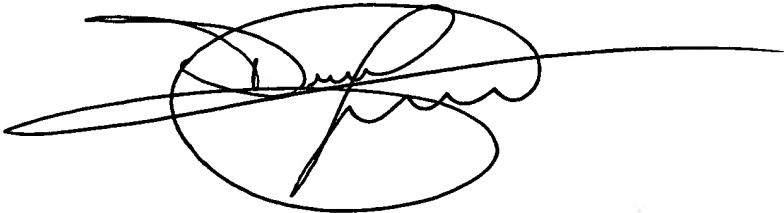
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr  
Primary Examiner  
Art Unit 2876

DS  
April 26, 2004

A handwritten signature in black ink, appearing to read "Daniel St.Cyr", is overlaid on a large, roughly circular, hand-drawn oval. The oval is roughly centered on the page and has an irregular, somewhat organic shape with a wavy bottom edge. The signature is positioned within this oval.